

Appl. No. 09/638,587

Docket No. 56838-010200

Amdt. dated February 14, 2005

Reply to Office action of November 17, 2004

REMARKS

Applicants have carefully considered the Final Office Action of November 17, 2004 and herein set forth detailed responses to the Examiner's assertions made in the Final Office Action.

Claims 6-10 are canceled without prejudice or disclaimer, and Applicants' reserve the right to pursue such claims in future related application or applications. These claims are cancelled in light of the Examiner's rejection of less than all of the claims under the judicially created obviousness-type double patenting rejection, which is obviated by the filing of the Terminal Disclaimer enclosed herein.

OATH/DECLARATION

The Examiner has stated that the oath or declaration is defective because it does not include inventor Lawrence Hecox's signature. The Examiner is respectfully directed to the concurrently filed Petition under 37 C.F.R. § 1.47, wherein proof of pertinent facts regarding unsuccessful attempts to contact and provide inventor Lawrence Hecox with an opportunity to execute an oath, in accordance with the Office Action of July 14, 2003, are detailed. It is also noted that recordation of assignment of the present application to E.S.P. Networks, Inc, by all inventors (including Lawrence Hecox), was recorded at the U.S. Patent and Trademark Office on August, 15, 2000.

It is also noted that inventor Joseph F. Scalisi, is both an inventor in the present application as well as an officer (President) of E.S.P. Networks, Inc., which has sufficient proprietary interest justifying his authorization to proceed and pursue and move forward the present application for Letters Patent (copy of previously provided Statement under 37 C.F.R. 3.73(b) enclosed).

Accordingly, the application is hereby made by another inventor (Joe Scalisi) on behalf of himself and the nonsigning inventor, in order to provide a response to the Final Office Action of November 17, 2004 that is, as required, fully responsive to Final Office Action and to preserves rights of the Assignee, E.S.P. Networks Inc.

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REJECTIONS UNDER 35 USC 103

The Examiner has rejected pending claims 5-10 and 18-26 UNDER 35 USC 103(a) as obvious over USP 5,117,449 (Metroka et al.) in view of USP 5,574,772 (Scalisi et al.) and in further view of USP 6,226,495 (Neustein). Applicant traverse these rejections and respectfully assert that the Examiner is confusing the caller/call receiver (entity calling or placing a call to the call receiving pager apparatus) with the call receiving pager apparatus/user and steps taken by each party. The relationship of signals/content/type/transmission between an outside caller/call receiver and the call receiving pager apparatus/user are recited and laid out in the claims.

The Examiner asserts (on Page 8, second paragraph of Office Action of 11/17/04) that Metroka et al. teaches a call receiving pager apparatus that includes transmitting means for "... b) transmitting at least one of a voice message, a text message, or data message to a telephone number preprogrammed into said call receiving pager apparatus wherein said message asks a call receiver at said preprogrammed telephone number to initiate a call to said call receiving pager apparatus..." and references col. 1, lines 26-30, col. 2, lines 19-23 and col. 6, lines 11-65 of Metroka et al. for support.

Taking a closer look at the cited portion of Metroka et al. reveals that these cited portions do not teach the recited limitations of claim 5, let alone the limitations of claims dependent therefrom. Col. 1 lines 26-30 relate to a caller calling a central paging control, accessing a desired pager and leaving either a voice mail for the paged individual or keying in a number to be displayed on the individual's pager display. Col. 2, lines 19-23 of Metroka et al., relate to shared memory storage of numbers in the apparatus that are entered via a keypad of the apparatus as well as paging data such as telephone numbers received from a paging system. Col. 6, lines 11-65 relates to shared memory usage, such as for storing and displaying messages received, reviewing a stored message, wherein the message includes a telephone number in the message, and placing a call without having to reenter the number from which the message was sent using this stored number. The remainder of cited Col. 6 generally relates to sending direct calls out to a caller at a number stored or not stored in memory, that is, where the person on the other side simply and conventionally answers the call, use and programming of a synthesized local oscillator and other components to change the receiving frequency of a secondary receiver of the apparatus and use of the keypad to program other parameters.

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There is no recitation or disclosure in Metroka et al. that relates to means for transmitting at least one of a voice message, a text message, or data message to a telephone number preprogrammed into a call receiving pager apparatus where the message (that is, the one transmitted from call receiving pager apparatus, as presently clearly claimed) asks a call receiver, at the preprogrammed telephone number, to initiate a call to the call receiving pager apparatus, as clearly recited in the claims. The placement/transmission and order of sequences of this specific request, for a call back to the call receiving pager apparatus (from a caller to the call receiving pager apparatus) is not mentioned or even suggested anywhere in the cited reference. The fact that such teachings are not found in this reference makes sense, since Metroka et al. is simply an apparatus having dual receivers to impart upon the apparatus disclosed therein the ability to receive paging and radiotelephone signal simultaneously (ABSTRACT) and operate accordingly.

The novel and nonobvious limitations of the presently pending claims are simply not found in the Metroka et al reference. This is not surprising, as the whole point of the Metroka et al. document is to disclose an apparatus that has combined, standard, pager and cellular radiotelephone features, as provided by the dual receivers of the apparatus.

Accordingly, Metroka et al. relates to the returning of calls or pages from an outside caller via the apparatus having the dual receivers disclosed therein, that is, simply and directly calling back a number that originally was utilized by a caller in an attempt to contact a user of the integrated paging and radiotelephone apparatus, that is all. There is absolutely no disclosure or mention in Metroka et al. relating to the transmitting of at least one of a voice message, a text message, or data message to a telephone number preprogrammed into a call receiving pager apparatus, wherein the message asks a call receiver at the preprogrammed telephone number to initiate a call to the call receiving pager apparatus, as presently claimed. Review of the cited portions of Metroka et al. evidence this lack of disclosure.

Additionally, the Examiner has asserted that Metroka et al. also teaches processing means for "...processing received cellular signals and only transmitting cellular signals in response to receipt of a signal having a correct mobile identification number of the pager apparatus...", also clearly recited in claim 5. This limitation is also not found in Metroka et al. Applicants respectfully request that the Examiner review the limitations of the pending claims and compare

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the limitations to the Examiner's cited portions of the references, particularly when taken in light of the whole of the cited document. The Examiner has cited Col. 1, lines 54-59 (page 8, 4th paragraph of Office Action of 11/17/04) of Metroka et al. to support this assertion. A close study of the cited sections reveals that what is disclosed is simply one aspect of a standard pager which allows one to receive the number of a calling party whether or not the pager user is near a radiophone and that a pager user can scroll through a list of pages from various numbers and call, via a telephone (a separate apparatus), a desired number.

This has nothing to do with the instant claims or application. The Examiner's cited text, taken in the context of the "Background of the Invention" section of Metroka et al. of which it is part of, is a discussion comparing and contrasting pager and cellular radiotelephone systems and apparatus, and how previously one would have to carry both apparatuses and how there is a need for an apparatus (Metroka et al.) that combines various aspects of both in one apparatus (next paragraph, Col. 1, lines 60-68 and Col. 2, lines 1-7).

Likewise, the Examiner's citation and reliance of Col. 6, lines 30-65 of Metroka et al. (page 8, 4th paragraph of Office Action of 11/17/04) for teachings relating to processing means for "...processing received cellular signals and only transmitting cellular signals in response to receipt of a signal having a correct mobile identification number of the pager apparatus..." do not comport with what Metroka et al. discloses and are thus improper.

As discussed above and in addition, Col. 6, relates to apparatus performance of "...cellular radiotelephone function in a conventional manner." (Col 6. lines 31-32) via keypad usage, that is, normal keying of a telephone number via a keypad into a cellular radiotelephone. Lines 30-65 relates to shared memory usage, such as for storing and displaying messages received, reviewing a stored message, wherein the message includes a telephone number in the message, and placing a call without having to reenter the number from which the message was sent, by using this stored number. The remainder of cited Col. 6 is generally relates to sending direct calls out to a caller, use and programming of a synthesized local oscillator and other components to change the receiving frequency of a secondary receiver of the apparatus via use of the key pad and use of the keypad to program other parameters of the combine apparatus.

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There is no teaching, suggestion or hint of limiting processing of cellular signals to "... received cellular signals and only transmitting cellular signals in response to receipt of a signal having a correct mobile identification number of the pager apparatus...", as positively recited in claim 5. Again, the apparatus of Metroka et al. is a dual receiver apparatus that allows it to receive paging signal simultaneously with radiotelephone signals, precisely because of its dual receivers, that is all. That is, Metroka et al. discloses an apparatus that simply can be considered as having the combined standard functions of a pager and a radiotelephone, and does not anticipate or even suggest the limitations of the apparatus positively recited in the pending claims of the present case (e.g. "...means for transmitting at least one of a voice message, a text message, or data message to a telephone number preprogrammed into a call receiving pager apparatus where the message (that is, the one transmitted from call receiving pager apparatus) asks a call receiver, at the preprogrammed telephone number, to initiate a call to the call receiving pager apparatus..."; or "...processing received cellular signals and only transmitting cellular signals in response to receipt of a signal having a correct mobile identification number of the pager apparatus..").

Now turning to the Examiner's reliance on Scalisi et al., Applicants respectfully note that once again and here also, the teachings of Scalisi et al., especially the portions relied upon by the Examiner, do not comport with the Examiner's assertions and are taken out of the context of the disclosure of Scalisi et al.. The Examiner points to Col. 2, lines 1-12 of Scalisi et al. to assert that caller only initiated direct, two-way wireless communication between a caller and a subscriber of a call receiving apparatus is disclosed. Applicants also note that the same paragraph in Scalisi et al. teaches that the "...present invention comprises a device that will only receive calls..." and that "The device has no keypad or related circuitry, so that no outgoing calls can be made on the device...but may be used to receive calls..."

Properly taking the whole of the document into consideration, one sees that teachings of Scalisi et al., in particular aspects, relate to a device that is only able to send signals once it receives an appropriate signal (e.g. Col. 4, lines 11-16). In reviewing the whole of the document, there is simply no mention of "means for transmitting at least one of a voice message, a text message, or data message to a telephone number preprogrammed into a call receiving pager apparatus where the message asks a call receiver, at the preprogrammed telephone number, to

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initiate a call to the call receiving pager apparatus..." as recited in claim 5. This is because of the simple fact that the device of cited Scalisi et al. can only transmit signals once it receives an appropriate one, as shown in some detail in Col. 5, lines 30-49.

The teachings of the Scalisi et al. citation simply do not relate to a call receiving pager apparatus operative in a radiotelephone communications system comprising, at least, transmitting means for a) transmitting cellular signals upon receipt of cellular signals by said receiving means to create a direct real-time two-way wireless communication between said call receiving pager apparatus and another telephone apparatus and b) transmitting at least one of a voice message, a text message, or data message to a telephone number preprogrammed into said call receiving pager apparatus wherein said message asks a call receiver at said preprogrammed telephone number to initiate a call to said call receiving pager in conjunction with means for a) processing said received cellular signals and only transmitting cellular signals in response to receipt of a signal having a correct mobile identification number of the pager apparatus. Such teachings are simply not found here, nor in the Metroka et al reference.

Applicants respectfully assert that there is no objective evidence provided by the Examiner to combine Metroka et al and Scalisi et al, and that even if combined, for some unknown reason, the combined teachings do not render the present claims obvious in light thereof and accordingly a prima facie case of obviousness has not been provided.

The Examiner has stated that the systems of Metroka et al. and Scalisi et al. are "analogous" because they are from the same field of endeavor, combined pager and telephone. A careful read of the whole of each of the documents shows that the device of Scalisi et al. cannot make any outwards call, or even request any calls, to the device. It is simply a receiver and can be utilized and only transmit signals once signals are received and recognized by the device. This is unlike the teachings of Metroka et al. where features of both a pager and radiotelephone are combined, as provided by the dual receivers. This device can make outgoing calls, just like any cell phone and does not have to have received a signal having an appropriate characteristic in order to transmit signals and conduct two way communications. As stated above and even more clearly by the documents themselves, the devices and teachings of Metroka et al. and Scalisi et al. are quite unrelated as to function and operating sequence of events

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It is well known that statements that modifications of the prior art to meet the claimed invention would have been " well within the ordinary skill of the art at the time the claimed invention was made " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

What is it in the disclosures *themselves* would have lead one to combine such teachings, let alone suggest any reasonable level of success of making the combination or how one would go about it? Given that there is nothing in the teachings that provide such a suggestion, Applicants' respectfully assert that the Examiner's suggestion or inclination to combine these disparate references, resultantly must be derived from some suggestion provided by the Applicants' disclosure, which would be improper and unallowable. Even if we were to combine the teachings of Metroka et al. and Scalisi et al., what would we have then?

Even contemplating combining the teachings of the Metroka et al. and Scalisi et al. disclosures is a difficult task, as the devices and capabilities disclosed therein are so unsuitable for use with each other and are directed to different apparatus and methods of use. Combining the "transmitting only upon receiving a particular signal" aspect of the Scalisi et al. disclosure, with the dual (pager and radiotelephone) receivers of Metroka et al. results in some sort of strange hybrid that defeats the very purposes of the respective devices. That is, the inability of the device in Scalisi et al. to initiate communication with other devices, and only in response to first receiving a proper signal having the correct characteristics (the device in cited Scalisi et al. does not even have a keypad, see, Col. 2, lines, an element that the device of Metroka et al. clearly requires) with the standard radiotelephone aspects of Metroka et al. (receiving all calls coming in and making any calls out in conventions manner) do not comport with each other. Such a combination is illogical given the teachings of the whole of the disclosures.

Yet even when combined, the positively recited limitations of independent claim 5, at least and for example, "...transmitting means for ...transmitting at least one of a voice message, a text message, or data message to a telephone number preprogrammed into said call receiving pager apparatus wherein said message asks a call receiver at said preprogrammed telephone number to initiate a call to said call receiving pager apparatus..." and "...processing means

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coupled to the receiving means and the transmitting means for a) processing said received cellular signals and only transmitting cellular signals in response to receipt of a signal having a correct mobile identification number of the pager apparatus..." *are not* found, taught or suggested.

As, shown above, there are clearly deficiencies in the cited references, that is, lack of teachings and/or suggestion of currently presented claim limitations. A close and careful reading of the documents, shows that teachings asserted by the Examiner are simply not to be found in the cited references, especially when particularly cited portions are properly taken in context and in light of the whole of the respective disclosures. The Federal Circuit has stated and makes clear that, "the deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is "basic knowledge" or "common sense" to one of ordinary skill in the art." *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. Aug 2, 2001). The Examiner has not provided any support for the obviousness rejections asserted in the Final Office Action of November 17, 2004, either in the cited references or by providing any evidence of what would have been basic knowledge" or "common sense" to one of ordinary skill in the art, in light of inapposite teachings provided when the disclosures are taken together.

The Neustein reference fails to remedy the deficiencies of Metroka et al. and Scalisi et al.. Here once again, the Examiner's assertions of what the reference teaches are not supported by references themselves. For example, the Examiner states (page 10, first full paragraph) that "Neustein teaches caller only initiated communication between a caller and subscriber of a call receiving pager apparatus wherein the caller is billed for the transmission of the call" at Col. 4, lines 22-26; Col. 7 lines 1-10; Col. 9, lines 52-59. A reading of the Neustein reference shows that it is directed to paggers and paging systems, in a conventional sense, that is, paggers and paging system configurations where paggers act only as signal receiving apparatus. The apparatus of Neustein does not and cannot send signals such that a calling party (here a user of a pager) communicates with a caller.

In fact, it is clearly stated in Col. 1 lines 34-42, that when reading the Neustein disclosure "... the individual placing the call is referred to as the caller, and the individual holding the pager apparatus as the called party. *Paging apparatus* differ from telephone equipment in that *paggers can only receive remotely transmitted signals and alert the called party but they do not have the*

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capability of transmitting responses. Thus, they cannot support real time, two-way communication. Hereinafter, reference to a pager, pager apparatus or receiver, refers to a receive only device of this type." (emphasis added). Thus, the whole of the disclosure of Neustein refers to apparatus very unlike the call receiving pager apparatus of the present application and even differs greatly from the apparatus of the primary reference, Metroka et al. Furthermore, Neustein does not at least recite or render obvious the limitations of the present claims. Independent claim 5 recites (as discussed above) limitations of transmitting and processing means that are not disclosed in the primary and secondary references, let alone in this tertiary reference that is directed to signal receiving-only pagers and pager central station particulars.

Thus and clearly the rejections of claims 5-10 and 18-26, under 35 103(a) , as being obvious over the cited U.S. patents to Metroka et al. in view of Scalisi et al and in further view of Neustein, are improper. Applicants respectfully request that the Examiner accordingly withdraw these rejections and find the claims allowable over the cited references.

DOUBLE PATENTING

The Examiner has provisionally rejected pending claims 5 and 18-26 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of co-pending application 09/499,058. Applicants note that the rejection is not directed to claims 6-10.

Therefore applicants have canceled claims 6-10, without prejudice or disclaimer, and reserve the right to pursue such claims in a related continuation application. These claims are cancelled in light of the Examiner's application of the provisional double patenting rejection to only a subset of the claims, namely 5 and 18-26. Enclosed is a Terminal Disclaimer, obviating the Examiner's provisional judicially created doctrine of obviousness-type double patenting rejection.

In view of the foregoing, it is respectfully submitted that the claims under consideration in the application (claims 5 and 18-26) are in condition for allowance. Allowance of the Claims at an early date is courteously solicited.

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If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call Applicants' undersigned representatives, attention Claude Nassif, Ph.D. at (310) 586-7828 to discuss the steps necessary for placing the application in condition for allowance.

No fee is believed due with this response. However, if Applicants are mistaken, the Director is authorized to charge any additional fee(s), including any required extension or petition fee, or any underpayment of fee(s), or to credit any overpayments to Deposit Account Number 50-2638, Deposit Account Name Greenberg Traurig, LLP, required of this or any other paper submitted during prosecution of this application. Please ensure that the Attorney Docket Number is referred to when charging any payments or credits for this case.

Respectfully submitted,
GREENBERG TRAURIG, LLP

Date: February 14, 2005By: 

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Enclosed: Statement under 37 C.F.R. 3.73(b)
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